

REMARKS

Claims 38, 53-55 and 66-84 are pending in the application. In this response, claims 38, 53, 54, 55 and 66 are amended. Claims 85-88 have been added in this response. No new matter is believed to be added by this amendment. Applicant submits that all of the claims are now in a form for allowance.

Claim Rejections – 35 U.S.C. § 103

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

In the Office Action, claims 38, 53-55, and 66-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacInnis et al. (USPN 6,570,579) in view of Boyce et al. (USPN 5,614,952) and Kalra et al. (USPN 5,953,506). In response to this assertion, Applicants have amended claims 38, 53, 54, 55 and 66. In effect, the amendments in each instance are directed toward claiming a DHCT that is configured to operate in a non-resource constrained mode and a plurality of resource-constrained modes. Support for these amendments can be found at least in paragraphs [0057] – [0063].

Therefore, because the prior art does not teach, suggest or make obvious all of the limitations that are found in claims 38, 53, 54, 55 and 66, specifically a DHCT that is configured to operate in a non-resource constrained mode and a plurality of resource-constrained modes, Applicants submit that claims 38, 53, 54, 55 and 66 are not obvious over MacInnis in view of Boyce and Kalra. As such, Applicants respectfully submit that claims 38, 53, 54, 55 and 66 are now in a form for allowance.

Claims 67-84 depend either directly or indirectly from claims 38, 53, 54, 55 and 66. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that because independent claims 38, 53, 54, 55 and 66 are now nonobvious, claims 67-84 (and new claims 85-88) are also nonobvious and are now in a form for allowance.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int'l Co. v. Teleflex, Inc. (KSR)*, No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of “the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). As stated above, MacInnis alone or in combination with Boyce and Kalra does not teach the limitation of the prior art, alone or in combination, does not teach, suggest or make obvious, a

DHCT that is configured to operate in a non-resource constrained mode and a plurality of resource-constrained modes, as claimed in independent claims 38, 53, 54, 55 and 66, from which claims 67-88 depend directly or indirectly. Boyce and/or Kalra do not correct the failings of MacInnis. It would not have been obvious to one of ordinary skill in the art to combine MacInnis in view of Boyce and Kalra, and the subject matter of the limitations not taught by either, to arrive at the presently claimed invention. Applicants earnestly request reconsideration, withdrawal of this rejection, and allowance of claims 38, 53-55, and 66-88.

Conclusion

Applicants have amended claims 38, 53, 54, 55 and 66, and have added claims 85-88. Applicants submit that the prior art does not teach, suggest, or make obvious the elements of claims 38, 53-55 and 66-88. Applicants submit that all the remaining claims of this application are now in a form for allowance, and respectfully request the Examiner to expeditiously do so.

Fees for the added claims and for a two-month extension of time accompany this paper and no other fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Applicants request the Examiner to contact the undersigned directly at 678-420-9354 if there are any comments or questions in regard to this paper.

Respectfully submitted,

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